

REMARKS

INTRODUCTION:

In accordance with the foregoing, claim 19 has been amended and new claim 20 has been added. The amendment and new claim each find support in at least at paragraph [0026] of the present application. Accordingly, no new matter is being presented, and approval and entry are respectfully requested.

Claims 2, 3, 5-8, 11-13, and 16-20 are pending and under consideration.
Reconsideration is respectfully requested.

REJECTION UNDER 35 U.S.C. §101:

Claim 19 stands rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. At least for the reasons herein, the rejection is traversed and reconsideration is respectfully requested.

The current Office Action asserts at page 2 that:

"Claim 19 is again rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter."

As acknowledged in the current Office Action, claim 19 is directed to "a display for use in a computer to reappear color." Accordingly, Applicants assert the display of claim 19 is thus submitted to fit specifically within one or another of the "machine" or "manufacture" categories of statutory subject matter under 35 U.S.C. § 101. As provided therein:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Since claim 19 falls within one of the four stated categories of statutory subject matter, claim 19 is submitted to be directed to statutory subject matter within the meaning of 35 U.S.C. § 101.

However, the current Office Action asserts at page 3 that:

"the claimed invention is an image that does not fall within the statutory classes of inventions specified in 35 U.S.C. § 101."

Applicants respectfully disagree. As provided in the Guidelines, the burden is on the USPTO to set forth a prima facie case of unpatentability. Thus, claims are presumed to belong to one of the four enumerated categories of patentable subject matter recited in 35 U.S.C. § 101 unless the Office is able to show otherwise. In particular, as provided in the Guidelines at page 16, lines 1-4:

The burden is on the USPTO to set forth a prima facie case of unpatentability. Therefore if the examiner determines that it is more likely than not that the claimed subject matter falls outside all of the statutory categories, the examiner must provide an explanation.

Here, the Office Action makes no attempt to reconcile the acknowledgment in the Office Action that claim 19 recites “a display,” with the contradictory assertion that claim 19 is directed to merely an image. As such, Applicants assert that the Office has failed to meet its burden to demonstrate that claim 19 is directed to an image as opposed to a display and thus falls outside all of the statutory categories.

However, even assuming for the sake of argument that claim 19 is directed to subject matter outside of the statutory categories, the analysis is not complete. According to the Guidelines, an examiner must ascertain the scope of the claim to determine whether it covers either a § 101 judicial exception or a practical application of a § 101 judicial exception. In particular, as provided in the Guidelines at page 18, lines 6-13:

An examiner must ascertain the scope of the claim to determine whether it covers either a § 101 judicial exception or a practical application of a § 101 judicial exception. The conclusion that a particular claim includes a § 101 judicial exception does not end the inquiry because “[i]t is now commonplace that an application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.” *Diehr*, 450 U.S. at 187, 209 USPQ at 8 (emphasis in original); accord *Flook*, 437 U.S. at 590, 198 USPQ at 197; *Benson*, 409 U.S. at 67, 175 USPQ at 675.).

As stated in the Guidelines on page 2, even if a claim includes a judicial exception and is directed to subject matter outside of the statutory categories, it may still be statutory if it recites a practical application. The Guidelines further explain that

“a practical application of a 35 U.S.C. § 101 judicial exception is claimed if the claimed invention physically transforms an article or physical object to a different state or thing, or if the claimed invention otherwise produces a useful, concrete, and tangible result.”

Here, the Office has made no attempt to determine whether claim 19 includes a judicial exception or otherwise produces a useful, concrete, and tangible result. As such, the analysis in

the Office Action is at best incomplete and the Office has failed to meet its burden that the claimed subject matter falls outside all of the statutory categories.

Accordingly, claim 19 is submitted to be allowable and withdrawal of the rejection is respectfully requested.

REJECTION UNDER 35 U.S.C. §102:

Claim 19 stands rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Pat. App. No. 2003/0193688 to Namikata ("Namikata"). At least for the reasons set forth herein, this rejection is traversed and reconsideration is respectfully requested.

Claim 19 recites at least:

"a list box to display one or more color reappearance peculiarity profiles and one or more color reappearance common profiles"

The current Office Action asserts that FIG. 6, item 604 of Namikata illustrates a "list box to display one or more color reappearance peculiarity profiles." Even assuming, arguendo, that this is correct, Applicants assert that Namikata fails to disclose or illustrate, in FIG. 6 or elsewhere, all of the features recited in claim 19 as currently amended.

Accordingly, Applicants respectfully submit that because Namikata fails to teach or suggest all of the features of claim 19, the claim is allowable over Namikata and withdrawal of the 102 rejection is respectfully requested.

NEW CLAIM:

New claim 20 is directed to at least "a list box to display one or more color reappearance peculiarity profiles and one or more color reappearance common profiles." Therefore, it is submitted that claim 20 patentably distinguishes over the prior art.

ALLOWED CLAIMS:

Claims 2, 3, 5-8, 11-13, and 16-18 are allowed over the prior art of record.

REQUEST FOR ENTRY IN ACCORDANCE WITH 37 CFR 1.116:

37 CFR 1.116 sets forth, inter alia, conditions under which an amendment after a final action may be entered. 37 CFR 1.116(b)(1) and (2) state that "[a]n amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action" and that "[a]n amendment presenting rejected claims in better form for consideration on appeal may be admitted." Accordingly, entry of this Amendment in accordance with 37 CFR 1.116 is respectfully requested.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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